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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/765,925	01/22/2001	Gerhard Buchholtz	260/020	8251
28204	7590	06/07/2005	EXAMINER	
SIEMENS SCHWEIZ I-44, INTELLECTUAL PROPERTY ALBISRIEDERSTRASSE 245 ZURICH, CH-8047 SWITZERLAND			THAI, CANG G	
			ART UNIT	PAPER NUMBER
			3629	

DATE MAILED: 06/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/765,925

Applicant(s)

BUCHHOLTZ, GERHARD

Examiner

Cang G. Thai

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03/02/2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 25-48 is/are pending in the application.
- 4a) Of the above claim(s) 27 & 39 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 25-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. The amendment filed on 03/02/2005 has been entered.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 25-36 are rejected under 35 U.S.C. 101 because the claimed of invention is directed to non-statutory subject matter.

In order for the claimed invention to be statutory subject matter, the claimed invention must fall within one of the statutory classes of invention as set forth in § 101 (i.e. a process, machine, manufacture, or composition of matter which has practical application in the technological arts).

Claim 25 recites "A method for the knowledge-based advising, managing and/or controlling a business process involving at least two parties, comprising of:

- a) logically interlinking process knowledge and/or expert knowledge in a database;
- b) generating an assessment that characterizes the status of business process based on the interlinked knowledge and partial process results;
- c) formulating a course of action from assessment for at least one of at least two parties;"

In the above claim, it is merely an abstract idea and do not produce a useful, tangible, concrete results which has practical application in the technological arts.

The "A method for the knowledge-based advising, managing and/or controlling a business process involving at least two parties" comprising the steps of (a)-(c) as shown are merely an abstract idea and does not reduce to a practical application in the technological arts (i.e. interaction in the steps with the computer/computer network or other equivalent means) and are therefore are found to be non-statutory. See *In re Alappat*, 33 F.3d at 1544, 31 USPQ2d at 1557, or *In re Waldbaum*, 173 USPQ 430 (CCPA 1972) or *In re Musgrave*, 167 USPQ (CCPA 1970) and *In re Johnston*, 183 USPQ 172.

Response to Arguments

3. Applicant's arguments filed 03/02/2005 have been fully considered but they are not persuasive. There is no technical subject matter is found in the body of the claim, therefore, it is merely an abstract idea and do not produce a useful, tangible, concrete results which has a practical application in the technological arts.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Applicant submitted Preliminary Amendment to cancel Claims 1-24. Claims 1-24 have been revised to conform to standard U.S. practice and replaced by claims 25-48.

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6. Claims 25-35 and 37-47 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,507,865 (HANSON ET AL.).

As for Claim 25, HANSON discloses a method for the knowledge-based managing of a business process involving at least two parties (Column 3, Lines 8-10), comprising the steps of:

- a) logically interlinking process knowledge or expert knowledge in a database {See Column 7, Lines 4-7, wherein this reads over “The server is connected to a message database that is used to manage the dynamic content”},
- b) generating an assessment that characterizes the status of business process based on the interlinked knowledge and partial process result {See Column 5, Lines 49-53, wherein this reads over “an activity in which one or more participants or services share information or point-of-view with an intent of reaching a decision making a choice, conducting a financial transaction, or sharing knowledge};
- c) formulating a course of action from assessment for at least one of at least two parties {See Column 5, Line 50, wherein this reads over “one or more participants or services”},
- d) signaling course of action to at least one party {See Column 5, Line 48, wherein this reads over “push technology process”}, and

Note: The preamble calls for three (3) options (advising, managing, and controlling) and “managing” is used in the rejection.

- e) wherein at least two parties have access to an information processor configured to provide at least two parties with interactive access to database for the process-accompanying input and storage of process knowledge or expert knowledge {See Column 6, Lines 1-4, wherein this reads over “the participant will have constant access to his or her at all times, and thereby can collaborate with other participants in the group quickly, simply and efficiently”}.

As for Claim 26, HANSON discloses a method as recited in Claim 25, wherein the interlinking step is based on at least one table configured for the structured gathering of expert knowledge {See Column 3, Lines 31-33, wherein this reads over “the textual content may include a list, work processing document, a table, a form, an outline, a calendar, or a slide presentation”}.

As for Claim 27, HANSON discloses a method as recited in Claim 25, wherein the interlinking step is based on at least one checklist (Column 3, Lines 31-33, wherein this reads over “the textual content may include a list, work processing document, a table, a form, an outline, a calendar, or a slide presentation”}.

As for Claim 28, HANSON discloses a method as recited in Claim 27, wherein the checklist comprises at least one milestone-related to work package comprising sub-process of business process. {See Column 13, Lines 29-31, wherein this reads over “the business logic may configure to track changes and modifications in the content”}.

As for Claim 29, HANSON discloses a method as recited in Claim 25, wherein the assessment-generating step comprises entering numerical values or marking areas

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in color. {See Column 15, Lines 49-52, wherein this reads over “the region may include options, such as a page or the quadrant of the page at which to sign the card, the angle at which the signature should be written, the front, the font color”}.

As for Claim 30, HANSON discloses a method as recited in Claim 25, wherein signaling step comprises automatically generating e-mail or setting a hyperlink. {See Column 5, Lines 15-18, wherein this reads over “a communication network is configured with participants supporting a variety of protocols, such as those for supporting electronic mail (“e-mail”) and the Internet”}.

As for Claim 31, HANSON discloses a method as recited in Claim 25, wherein course of action comprises formulating, defining, supplementing or executing work packages, requirements, functions, functional descriptions, system analysis, components, process descriptions, technical features, target values, assessments, priorities, risks or actions of reducing risks {See Column 5, Lines 44-47, wherein this reads over “for example, an open action may occur when a user invokes the File Open command from a menu bar within an e-mail reading program while an e-mail message containing a zaplet (network) is selected”}.

As for Claim 32, HANSON discloses a method as recited in Claim 25, wherein the process knowledge contained in the database is based on the process managing. {See Column 7, Lines 30-33, wherein this reads over “the database contains a record of the history of changes that have been made to any dynamic content region of the zaplet (network)”}.

As for Claim 33, HANSON discloses a method as recited in Claim 32, wherein business process comprises a product production process {See Columns 17-18, Lines 63-67 & Lines 1-2, wherein this reads over “the investment decisions may be made by clicking on the button to highlight the selection in a conventional manner. The investment decisions using the button may be submitted using the button. The dynamic content region may include comments received from the field and may be concatenated using the business logic”}.

As for Claim 34, HANSON discloses a method as recited in Claim 25, wherein interactive access to database comprises a communication network {Column 3, Lines 8-10, wherein this reads, “a system for content collaboration among group of participants would include a server having an associated database and adapted to be used in a network”}.

As for Claim 35, HANSON discloses a method as recited in Claim 34, wherein communication network comprises the Internet or a company-internet intranet {Column 5, Lines 15-18, wherein this reads, “a communication network is configured with participants that support a variety of protocols, such as those for supporting electronic mail (“e-mail”) and the Internet”}.

As for Claim 37, HANSON discloses a data processing system for the knowledge-based managing of a business process involving at least two parties (Column 3, Lines 8-10), comprising the steps of:

- a) logically interlink process knowledge or expert knowledge in a database
{See Column 3, Lines 10-15, wherein this reads over “The server

- generates and sends an electronic message to the participants and sends an electronic message to the participants, and the server generates and sends an electronic medium stored in the database to at least one participants in response to a first open action of the electronic message by at least one participant"},
- b) generate an assessment that characterizes the status of business process based on the interlinked knowledge and partial process results {See Column 5, Lines 49-53, wherein this reads "an activity in which one or more participants or services share information or point-of-view with an intent of reaching a decision, making a choice, conducting a financial transaction, or sharing knowledge."},
 - c) formulate a course of action from assessment for at least one of at least two parties {See Column 5, Line 50, wherein this reads over "one or more participants or services"},
 - d) signal course of action to at least one party {See Column 5, Line 48, wherein this reads over "push technology process"}, and
 - e) wherein at least two parties have access to an information processor configured to provide at least two parties with interactive access to database for the process-accompanying input and storage of process knowledge or expert knowledge {See Column 6, Lines 1-4, wherein this reads over "The participant will have constant access to his or her at all

times, and thereby can collaborate with other participants in the group quickly, simply and efficiently”}.

As for Claim 38, HANSON discloses the data processing system as recited in Claim 37, wherein the interlinking step is based on at least one table configured for the structured gathering of expert knowledge (Fig. 16, Element 1120).

As for Claim 39, HANSON discloses the data processing system as recited in Claim, wherein the interlinking step is based on at least one checklist (Fig. 16, Element 1140).

As for Claim 40, HANSON discloses the data processing system as recited in Claim 39, wherein the checklist comprises at least one milestone-related to work package comprising sub-process of business process. {Column 12, Lines 29-31, wherein this reads over “Further, the business logic may configure to track changes and modifications in the content.”}.

As for Claim 41, HANSON discloses the data processing system as recited in Claim, wherein the assessment-generating step comprises entering numerical values or marking areas in color (Element 704). {Column 15, Lines 49-52, wherein this reads over “ the region may include options, such as a page or the quadrant of the page at which to sign the card, the angle at which the signature should be written, the front, the font color”}.

As for Claim 42, HANSON discloses the data processing system as recited in Claim 37, wherein signaling step comprises automatically generating e-mail or setting a hyperlink {Column 5, Lines 15-18, wherein this reads over “a communication network is

configured with participants supporting a variety of protocols, such as those for supporting electronic mail ("e-mail") and the Internet"}.

As for Claim 43, HANSON discloses the data processing system as recited in Claim 37, wherein course of action comprises formulating, defining, supplementing or executing work packages, requirements, functions, functional descriptions, system analysis, components, process descriptions, technical features, target values (Element 920), assessments, priorities, risks or actions of reducing risks. {Column 5, Lines 44-47, wherein this reads over "for example, an open action may occur when a user invokes the File Open command from a menu bar within an e-mail reading program while an e-mail message containing a zaplet (network) is selected"}.

As for Claim 44, HANSON discloses the data processing system as recited in Claim 37, wherein the process knowledge contained in the database (Element 5) is based on the process knowledge-based managing. {Column 7, Lines 30-33, wherein this reads over "the database contains a record of the history of changes that have been made to any dynamic content region of the zaplet (network) discussed"}.

As for Claim 45, HANSON discloses the data processing system as recited in Claim 44, wherein business process comprises a product production process. {See Columns 17-18, Lines 63-67 & Lines 1-2, wherein read over "The investment decisions may be made by clicking on the button to highlight the selection in a conventional manner. The investment decisions using the button may be submitted using the button. The dynamic content region may include comments received from the field and may be concatenated using the business logic."}.

As for Claim 46, HANSON discloses the data processing system as recited in Claim 37, wherein interactive access to database (Element 7) comprises a communication network (Element 5) {Column 3, Lines 8-10, wherein this reads over "system for content collaboration among group of participants would include a server having an associated database and adapted to be used in a network"}.

As for Claim 47, HANSON discloses the data processing system as recited in Claim 46, wherein communication network (Element 5) comprises the Internet (Element 1) or a company-internet intranet {Column 5, Lines 15-18, wherein this reads over, "a communication network is configured with participants that support a variety of protocols, such as those for supporting electronic mail ("e-mail") and the Internet"}.

Response to Arguments

7. Applicant's arguments with respect to claims 25-35 and 37-47 have been considered but are moot in view of the new ground(s) of rejection.

Hanson's electronic form (electronic mail message) such as Fig. 12 is a checklist that contains knowledge and a corresponding evaluation from team members in the project or process management. The electronic mail message (checklist) may also include asynchronously dynamically updating and dynamically retrieving input from any of the participants about the content.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 36 and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,507,865 (HANSON ET AL.) as applied to claims 25-35 & 37-47 above, and further in view of U.S. Patent No. 6,277,071 (HENNESSY ET AL.).

As for Claim 36, HANSON discloses only one party (Web/Email Client) interlinking to the network (Fig. 1, Elements 1-5).

HENNESSY discloses at least two parties comprise one or more members of company management, project teams, suppliers, customers and/or advisers (Fig. 1, Element 24 and Element 30).

It would have been obvious to one of ordinary skill in the art at the time the invention was made, to modify the HANSON only one party (Web/Email Client) (Element 1) as customers interlinking to the network (Element 5) with at least two parties (Element 24 and Element 30) comprise one or more members of company management into the database (Element 29), as taught by HENNESSY. While HENNESSY does not disclose at least two parties of company management, project teams, suppliers, customers and/or advisers is merely an obvious design choice within the skill of one ordinary skill in the art to use other than Web/Email Client as customers form a network with providers and third parties (Column 6, Lines 5-6), as taught by HENNESSY.

As for Claim 48, it has same limitation to Claim 36 therefore; it is rejected for the same reason set forth in Claim 36.

Response to Arguments

10. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, it would have been obvious to one of ordinary skill in the art at the time the invention was made, to modify the HANSON only one party (Web/Email Client) (Element 1) as customers interlinking to the network (Element 5) with at least two parties (Element 24 and Element 30) comprise one or more members of company management into the database (Element 29), as taught by HENNESSY. It would have been obvious to one of ordinary skill in the art at the time of the invention was made, to modify the HANSON (Web/Email Client) to include at least two parties for storing plurality of data entries, as taught by HENNESSY. While HENNESSY does not disclose at least two parties of company management, project teams, suppliers, customers and/or advisers is merely an obvious design choice within the skill of one ordinary skill in the art to use other than Web/Email Client as customers form a network with providers and third parties (Column 6, Lines 5-6), as taught by HENNESSY.

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

No claims are allowed.


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cang (James) G. Thai whose telephone number is (571) 272-6499. The examiner can normally be reached on 6:30 AM - 3:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CGT
05/31/2005


DEANT. NGUYEN
PRIMARY EXAMINER *5/31/05*